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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/057,261	04/08/1998	TIMOTHY P. O'HAGAN	TELNP0157US	6228

23623 7590 06/06/2002

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CLEVELAND, OH 44114

EXAMINER

KNEPPER, DAVID D

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/057,261

Applicant(s)

O'HAGAN, TIMOTHY P.

Examiner

David D. Knepper

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8-18,20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-18,20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

1. Applicant's correspondence filed on 25 March 2002 (paper #19) has been received and considered. Claims 1, 2, 4, 5, 8-18, 20 and 22 are pending.

REMARKS

2. Applicant's arguments that Barclay teaches away from the invention ignore what he teaches about the prior art. The problem with the applicant's arguments is that they fail to consider what Barclay teaches about the prior art. The invention that Barclay claims is not what the examiner is relying upon. The examiner is relying on the description of prior art in columns 1-3. The hardware elements of figures 1, 4 and 6 relied upon are generic and would exist on any client – server relationship through the internet. In column 2, lines 65-66, Barclay teaches that it is well known for client software to run on a laptop or other such small computer. Therefore, it is clear that Barclay suggests the use of a mobile unit. It is notoriously well known that small computers (laptops, PDAs, etc.) were specifically designed to be mobile.

The argument that Barclay fails to teach communicating a dictionary file from a host computer to a mobile device is also in error. In column 3, lines 9-17, Barclay teaches that the grammar is, in effect distributed and down loaded when a Web page for specific topics is entered, called a "smart page". The example given is downloading a weather page. ... a weather report page could have a grammar specific to words and phrases associated with the weather ... the vocabularies and grammars are small. Thus, it is clear that prior art sends a vocabulary from a host computer to the client (mobile laptop, etc.).

While Barclay's invention is concerned about clients that do not have enough memory to store a large enough vocabulary to be useful, his description of the prior art makes it clear that the ability to download a useful vocabulary to a mobile user device (such as a laptop computer) is well known. Therefore, Barclay teaches one of ordinary skill in the art that if a client device has sufficient storage capacity and computational power, it is obvious to download a useful vocabulary to the user with prior art technology (i.e. – SAM).

Applicant is referred to the rejection of paper #17 (Office Action mailed 14 December 2001).

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. **Any response to this action should be mailed to:**

Box AF  
Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

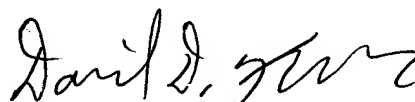
TC2600 Fax Center  
(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (703) 305-9644. The examiner can normally be reached on Monday-Thursday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached on (703) 305-4379.

Any inquiry of a general nature or relating to the status of this application should be directed to customer service whose telephone number is (703) 306-0377.



David D. Knepper  
Primary Examiner  
**Art Unit 2654**  
June 6, 2002